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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1994

BB ASSET MANAGEMENT, INC. A NEVADA CORPORATION, dba BROWN BAG SOFTWARE ("BROWN BAG")

PETITIONER

VS.

SYMANTEC CORPORATION ("SYMANTEC") AND JOHN L. FRIEND ("MR. FRIEND"), AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

BRIAN J. FLYNN
(COUNSEL OF RECORD)
P.O. BOX 61704
SUNNYVALE, CA 94088
ATTORNEY FOR PETITIONER

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QUESTIONS PRESENTED

I. WHAT ARE THE PARAMETERS OF FRCP 7'S REQUIREMENT THAT THE GROUNDS FOR MOTIONS BE STATED WITH PARTICULARITY? DID RESPONDENTS STATE THE GROUNDS FOR THEIR SUMMARY JUDGMENT MOTIONS WITH SUFFICIENT PARTICULARITY?

II. ARE DISTINCTIVENESS AND SECONDARY MEANING BOTH INDISPENSABLE ELEMENTS OF A TRADE DRESS CAUSE OF ACTION?

III. IS THE "LOOK AND FEEL" OF A COMPUTER SOFTWARE PROGRAM A FORM OF TRADE DRESS PROTECTED UNDER LANHAM ACT SECTION 43(a), 15 U.S.C. SECTION 1125(a), FALSE DESIGNATION OF ORIGIN? IS BROWN BAG'S EVIDENCE OF TRADE DRESS INFRINGEMENT OF THE "LOOK AND FEEL" OF ITS COMPUTER SOFTWARE PROGRAM, PC-OUTLINE, SUFFICIENT TO WITHSTAND SUMMARY JUDGMENT ON ITS LANHAM ACT CLAIM?

LIST OF ALL PARTIES

PETITIONERS

BB ASSET MANAGEMENT, INC. A NEVADA CORPORATION, dba BROWN BAG SOFTWARE ("BROWN BAG")

RESPONDENTS

SYMANTEC CORPORATION ("SYMANTEC") A DELAWARE CORPORATION, AND JOHN L. FRIEND ("MR. FRIEND") AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

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VS.

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RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner respectfully requests that a Writ of Certiorari issue to review the unpublished Memorandum disposition of the United States Court of Appeals for the Ninth Circuit entered in this proceeding on June 28, 1994 and Order which denied Petitioner's Petition for Rehearing entered in this proceeding on July 28, 1994.

CITATIONS TO OPINIONS BELOW

The Order which denied Petitioner's Petition for Rehearing by the Court of Appeals entered in this proceeding on July 28, 1994 appears as Appendix E to this Petition.

The unpublished Memorandum disposition of the Court of Appeals, appears as Appendix D to this Petition.

The Order Granting Summary Judgment of Plaintiff's Lanham Act Claim, filed November 12, 1992, United States District Court, Northern District of California, San Jose Division, appears as Appendix B to this Petition.

The Judgment Nunc Pro Tunc, filed November 24, 1992, United States District Court, Northern District of California, San Jose Division, appears as Appendix C to this Petition.

The applicable section of the opinion of the Court of Appeals, reported as Brown Bag Software v. Symantec Corporation, 960 F.2d 1465 (9th Cir. 1992), appears as Appendix A to this Petition.

JURISDICTION

Denial of Petitioner's Petition for Rehearing by the Court of Appeals for the Ninth Circuit was entered July 28, 1994. This Petition for a Writ of Certiorari was filed within ninety days of that date. This Court's jurisdiction is invoked under 28 U.S.C. Section 1254(1).

STATUTORY PROVISIONS INVOLVED

28 U.S.C. Rule 7 (FRCP 7) -- Appendix H.

28 U.S.C. Section 1125(a), Lanham Act Section 43(a) -- Appendix I.

STATEMENT OF THE CASE

NATURE OF THE CASE

Petitioner BB Asset Management, Inc. dba Brown Bag Software ("Brown Bag") is engaged in the marketing of computer software programs. One of the programs marketed by Brown Bag is PC-Outline, a personal information management system which, among other things, permits its user to organize, store and manipulate information in outline form. Much of PC-Outline's commercial success is attributed to the unique sequence, layout and organization of its features and audio-visual displays.

PC-Outline was created by Respondent John L. Friend ("Mr. Friend"). On April 17, 1987, Brown Bag and Mr. Friend entered into a written Purchase and Sale Agreement (the "Agreement") whereby Brown Bag acquired from Mr. Friend all right, title and interest in and to PC-Outline. The Agreement stated that Mr. Friend was to receive no license to reproduce, adapt or distribute PC-Outline, or any right to utilize the "look and feel" of PC-Outline. The agreement was attached to Brown Bag's complaint.

Brown Bag Software, Inc., name changed from Telemarketing Resources, Inc. dba Brown Bag Software, filed for bankruptcy protection under Chapter 11 on December 11, 1989. Subsequently, a secured creditor purchased certain

assets of Brown Bag, including PC-Outline, at a foreclosure sale, and transferred these assets to the newly formed corporation, BB Asset Management, Inc. dba Brown Bag Software. For continuity, plaintiff/appellant/petitioner shall be referred to thoughtout this appeal as "Brown Bag" which shall include Brown Bag Software, Inc., Telemarketing Resources, Inc. dba Brown Bag Software and BB Asset Management, Inc. dba Brown Bag Software.

PROCEEDINGS BELOW

Soon after Symantec started marketing Grandview, Brown Bag filed a complaint in district court against Symantec and Mr. Friend as co-defendants for the federal claims of copyright infringement and violation of Section 43(a) of the Trademark laws of the United States. The complaint also contained related state law claims.

Symantec and Mr. Friend moved for summary judgment. On September 7, 1989, the district court entered judgment for Symantec and Mr. Friend on all federal claims based solely on its summary judgment on the copyright claim without consideration of Brown Bag's claim based on Section 43(a) of the Trademark laws of the United States. Brown Bag v. Symantec Corp., 12 USPQ 1991 (N.D.CA. 1989). The district court decided not to exercise its pendent jurisdiction over the state law claims and dismissed them without prejudice.

Brown Bag appealed the district court's judgment to the Court of Appeals. Issues on appeal included Brown Bag's copyright infringement claim, Section 43(a) claim and a right to counsel issue based on the denial of access to confidential documents of Brown Bag's counsel of record/litigation counsel under a protective order because he was Brown Bag's employed in-house counsel rather than retained outside counsel. The Court of Appeals affirmed the district court as to the copyright infringement and right to counsel issues. The Supreme Court of the United States denied Brown Bag's petition for writ of certiorari on October 5, 1992. The Court of Appeals had remanded Brown Bag's Section 43(a) Lanham Act trademark/trade dress claim. The Court of Appeals stated that the record did not support an inference that the district court granted summary judgment on the Lanham Act claim. Brown Bag v. Symantec Corp., 960 F.2d 1465, 1478 (9th Cir. 1992). In Footnote 6, on page 1477 of Brown Bag, (Appendix A, Page a4) the Court of Appeals stated:

> Because Brown Bag alleged in its complaint a false designation of origin claim, however, Brown Bag need not have shown that Symantec and Friend infringed Brown Bag's Copyright in PC-Outline in order to state a claim under the Lanham Act that Symantec and Friend falsely promoted Grandview as an updated version of PC-Outline. Summary judgment on Brown Bag's copyright infringement claim, therefore, did not compel summary judgment on its Lanham Act claim.

The district court held a status conference on November 6, 1992 at which the court heard the arguments of the parties

regarding Brown Bag's Lanham Act Section 43(a) claim. In the status conference transcript, Page 14, Lines 1-4, the district court stated:

> Under the Federal Rules of Civil Procedure we have noticed pleadings in Federal Court, and it's just a question of whether there is sufficient notice, and I'll look at it again in that light.

Symantec's Memorandum of Points and Authorities in Support of Motion for Summary Judgment, at Page 38 (Appendix F, Page f2), contained the words "Telemarketing's pendant state claims against Symantec -- false designation of origin and unfair competition..." which were located under the heading "TELEMARKETING'S PENDANT STATE CLAIMS ARE DEPENDENT ON ITS COPYRIGHT INFRINGEMENT CLAIMS AND ARE BASELESS." Mr. John L. Friend's Memorandum of Points and Authorities in Support of Motion for Summary Judgment (Appendix G) described a Lanham Act cause of action for false advertising, not Brown Bag's cause of action for false designation of origin.

The district court entered its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim on November 12, 1992 (Appendix B) and its Judgment Nunc Pro Tunc on November 24, 1992 (Appendix C). In its Order entered on November 12, 1992, the district court stated "... Plaintiff presented no evidence in support of its claim for false designation of origin." (Appendix B, Page b3) Brown Bag ap-

pealed to the Court of Appeals for the Ninth Circuit. Brown Bag presented the following questions for review:

I. Is the "look and feel" of a computer software program a form of trade dress protected under Lanham Act Section 43(a), 15 U.S.C. Section 1125(a)?

II. Did Brown Bag submit sufficient evidence of trade dress infringement of its computer software program, PC-Outline, to withstand summary judgment on its Lanham Act Claim?

III. Did the moving parties provide adequate notice that they were moving for summary judgment on Brown Bag's Lanham Act trade dress claim for false designation of origin?

The court of Appeals, in its Memorandum disposition (Appendix D), affirmed the district court's grant of summary judgment on Brown Bag's claim for false designation of origin/trade dress under Lanham Act Section 43(a), 15 U.S.C. Section 1125(a).

Regarding Brown Bag's false designation of origin/trade dress claim, the Court of Appeals stated in its Memorandum disposition: "... there is no evidence raising a triable issue of fact on distinctiveness and secondary meaning -- which are indispensable elements." (Appendix D, Page d3) Relying on Two Pesos, Inc, v. Taco Cabana, Inc., 505 US_, 120L.Ed. 615, 1125S.Ct. 2753, Brown Bag filed a Petition for Rehearing on the grounds that distinctiveness and secondary mean-

ing were not both indispensable elements of a false designation of origin/trade dress cause of action. Brown Bag's Petition for Rehearing was denied (Appendix B).

REASONS FOR GRANTING THE WRIT

I. THE PARAMETERS OF FRCP 7'S REQUIREMENT THAT THE GROUNDS FOR MOTIONS BE STATED WITH PARTICULARITY HAVE YET TO BE DEFINED. PETITIONER PLEADS THAT THE GROUNDS FOR RESPONENTS' MOTIONS FOR SUMMARY JUDGMENT WERE NOT STATED WITH PARTICULARITY.

PROCEEDINGS TO DATE

The district court examined sufficiency of notice at the status conference. The transcript of the status conference states at Page 14, Lines 1-4:

> Under the Federal Rules of Civil Procedure we have noticed pleadings in Federal Court, and its just a question of whether there is sufficient notice, and I'll look at it again in that light.

In its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim, filed November 12, 1992, the district court stated (Appendix B, Page b3):

> In the moving papers, Defendant John Friend specifically reviewed the Lanham Act Claim and the lack of evidence to support such a claim. Defendant Symantec included the false designation of origin in its discussion of summary judgment for the state law claims.

In its Memorandum disposition, the Court of Appeals stated (Appendix D, Page d3):

> Even though Brown Bag argues that it didn't realize summary judgment was being sought on its Lanham Act claim, Symantec's notice of motion indicates that it sought judgment on all claims; moreover, the grounds offered in support include the evidence that Symantec falsely promoted Grandview as being an upgrade, derivative, or improvement upon PC-Outline, tracking exactly Brown Bag's fourth claim for relief.

F. R. C. P. Rule 7(b)(1) states:

> An application to the court for an order shall be by motion which, unless made during a hearing or trial, shall be made in writing, shall state with particularity the grounds therefor, and shall set forth the relief or order sought.

F. R. C. P. Rule 7, requiring that a motion state with particularity the grounds therefor, applies to a motion for summary judgment. Upper W. Fork River Watershed v. Corps of Engrs., 414 F.Supp. 908 (D.C.W.Va. 1976), affirmed 556 F.2d 576, certiorari denied 98 S.Ct. 720, 434 U.S. 1010, 54 L.Ed.2d 752. In Upper W. Fork River Watershed, the court stated at Page 918:

> Rule 7(b)(1), F.R.Civ.P., requires that a motion "state with particularity the grounds therefor." This provision applies to motions for summary judgment. 6 J. Moore, Federal Practice Paragraph 56.14[1], at 56-354 (2d Ed. 1976).

In Registration Control Systems v Compusystems, Inc., 922 F.2d 805 (Fed. Cir. 1990), the court stated at Page 807: "In their briefs, and at oral argument, the parties conceded, and we agree, that there is no controlling precedent from either the Supreme Court or the Seventh Circuit construing the parameters of Rule 7's requirement for particularity..." The court went on to say at Pages 807 and 808:

> The purpose of the particularity requirement in Rule 7 is to afford notice of the grounds and prayer of the motion to both the court and the opposing party, providing that party with a

> meaningful opportunity to respond and the court with enough information to process the motion correctly. Wright and Miller state that the issue is whether any party is prejudiced by a lack of particularity or "whether the court can comprehend the basis for the motion and deal with it fairly." 5 Wright & Miller, Federal Practice and Procedure Section 1192, 42 (1990).

" ... [T]he burden on the moving party may be discharged by 'showing' - that is, pointing out to the district court - that there is an absence of evidence to support the nonmoving party's case." Celotex Corp. v Catrett, 477 U.S. 317, at Page 325. The Celotex Court expanded upon and clarified the foregoing statement. The Celotex Court stated at Page 323:

> Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any," which it believes demonstrate the absence of a genuine issue of material fact.

The Celotex Court stated at Page 324:

> In cases like the instant one, where the nonmoving party will bear the burden of proof at trial on a dispositive issue, a summary judgment motion may prudently be made in reliance solely on the "pleadings, depositions, answers to interrogatories, and admissions on file."

The Celotex Court stated at Page 328: (Justice White, concurring.):

> I also agree that the movant may rely on depositions, answers to interrogatories, and the like, to demonstrate that the plaintiff has no evidence to prove his case and hence that there can be no factual dispute. But the movant must discharge the burden the Rules place upon him: It is not enough to move for summary judgment without supporting the motion in any way or with a conclusory assertion that the plaintiff has no evidence to prove his case.

THE FACTS/EVIDENCE

Symantec's Notice of Motion and Motion for Summary Judgment, at Page 2, contained the words:

> There is no evidence that Symantec or its agents falsely promoted GrandView as being an upgrade, derivative or improvement upon PC-Outline in a manner as to suggest a connection with plaintiff or to mislead consumers as to the source of Grandview.

Symantec's foregoing statement was not attributed to any specific cause of action brought by Brown Bag. However, a similarity worded statement in Symantec's Memorandum of Points and Authorities (Footnote 24 on Page 38) (Appendix F, Page f2) was attributed to Brown Bag's state law claims as described below.

In Symantec's Memorandum of Points and Authorities in Support of Motion for Summary Judgment, filed April 4,

1989, at Page 38 (Appendix F, Page f2), the words "Telemarketing's pendant state claims against Symantec -- false designation of origin and unfair competition -- are inextricably tied to its copyright infringement claim. Since the copyright infringement claim is lacking in substance, the related pendant state claims have no basis either." were located under the heading "TELEMARKETING'S PENDANT STATE CLAIMS ARE DEPENDENT ON ITS COPYRIGHT INFRINGEMENT CLAIMS AND ARE BASELESS." Symantec's Footnote 24 on Page 38 (Appendix F, Page f2) is appended to the words "pendant state claims." Thus, a reader would not refer to the footnote for information on a federal claim.

The Court of Appeals stated in its Memorandum disposition (Appendix D, Page d3) that Symantec's moving language tracked Brown Bag's fourth claim for relief. However, as shown in Appendix F, that language is contained in Footnote 24 which is appended to the words "pendant state claims." The Court of Appeals also pointed out in its Memorandum disposition that Symantec's notice of motion indicated that it sought judgment on all claims. (Appendix D, Page d3) Does such a general statement contain sufficient particularity in the absence of a clear statement of the grounds in the Memorandum of Points and Authorities?

Symantec has failed to state with particularity the basis for summary judgment on Brown Bag's "false designation of origin" Lanham Act claim for the following reasons:

A. Symantec has buried the words "false designation of origin" in material concerning Brown Bag's state law claims.

B. Symantec has stated simply that the state claims had no basis since they were "inextricably tied to its copyright infringement claim." The Court of Appeals stated: "Because Brown Bag alleged in its complaint a false designation of origin claim, however, Brown Bag need not have shown that Symantec and Friend infringed Brown Bag's copyright in PC-Outline in order to state a claim under the Lanham Act that Symantec and Friend falsely promoted GrandView as an updated version of PC-Outline." Brown Bag, 960 F.2d 1465, at Page 1477, Footnote 6 (Appendix A, Page a4).

C. Symantec has simply alleged that there is an absence of evidence and cites Celotex Corp., 477 U.S. 317, at Page 325.

However, Celotex states at Page 323:

> Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of "the pleadings, deposition, answer to interrogatories, and admissions on file, together with the affidavits, if any," which it believes demonstrate the absence of a genuine issue of material fact.

Justice White, concerning in Celotex at Page 328, states:

> I also agree that the movant may rely on depositions, answers to interrogatories, and

> the like, to demonstrate that the plaintiff has no evidence to prove his case and hence that there can be no factual dispute. But the movant must discharge the burden the Rules place upon him: It is not enough to move for summary judgment without supporting the motion in any way or with a conclusory assertion that the plaintiff has no evidence to prove his case.

D. Symantec's Footnote 24 is appended to the words "pendant state claims."

In its Memorandum disposition, The Court of Appeals did not rely on Mr. Friend's Motion. This is perhaps because Mr. Friend's Memorandum of Points and Authorities in Support of Motion for Summary Judgment discusses the elements of a false advertising Lanham Act cause of action as described in U-Haul Int'l v. Jartan, Inc., 522 F.Supp. 1238 (D. Ariz. 1981), aff'd, 681 F.2d 1159 (9th Cir. 1982). (Appendix G) In U-Haul, the district court stated: "I am called on to decide whether a stipulated preliminary injuction preventing certain cost comparison advertising should be extended to cover allegedly false and deceptive advertising involving equipment qualities of the advertiser or claimed comparisons with a competitor." U-Haul Int'l, 522 F. Supp. 1238 at Page 1240. The Court of Appeals stated: "A literal reading of Section 43(a) indicates that it embraces either a 'false designation of origin' or a 'false description or representation.'" (Citation omitted.) U-Haul Int'l, 681 F.2d 1159, at Page 1160. The Court of Appeals concluded: "In sum, we hold that U-Haul's claim that Jartran falsely represented its products and services in its comparative advertising cam-

paign in interstate commerce states a cause of action under Section 43(a) of the Lanham Act, 15 U.S.C. Section 1125(a)." U-Haul Int'l 681 F.2d 1159, at Page 1162. "[t]he Lanham Act provides civil redress to one damaged by unfair competition through false or misleading advertising and/or trademark or trade dress infringement." Romm Art Creations Ltd. v. Simcha International Inc., 22 USPQ2d 1801, at Page 1805. Since Brown Bag's cause of action involved false designation of origin and not summary false description or representation, Mr. Friend did not bring a motion for judgment on Brown Bag's claim.

However, the district court stated in its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim (Appendix B, Page b3): "In the moving papers, Defendent John Friend specifically reviewed the Lanham Act Claim and the lack of evidence to support such a claim." A review of Mr. Friend's language (Appendix G), shows that Mr. Friend did not review the elements of the false designation of origin cause of action. He reviewed the elements of a false or misleading advertising cause of action. The Court of Appeals did not rely upon or refer to Mr. Friend's motion in its Memorandum Disposition.

II. DISTINCTIVENESS AND SECONDARY MEANING ARE NOT BOTH INDISPENSABLE ELEMENTS OF A TRADE DRESS CAUSE OF ACTION.

The Court of Appeals stated in its Memorandum disposition filed June 28, 1994 (Appendix D, Page d3): "...even

if a trade dress theory had been timely raised, there is no evidence raising a triable issue of fact on distinctiveness and secondary meaning - - which are indispensable elements."

Brown Bag respectfully suggests that distinctiveness and secondary meaning are not indispensable elements. Both elements need not be shown. The showing of one element will suffice. "...[P]roof of secondary meaning is not required to prevail on a claim under Section 43(a) of the Lanham Act where the trade dress at issue is inherently distinctive..." Two Pesos, Inc., 120 L.Ed.2d 615, at Page 628.

Brown Bag's Petition for Rehearing on this issue was denied (Appendix E).

Brown Bag's evidence was discussed in its briefs submitted to the Court of Appeals.

Brown Bag's briefs discuss evidence of deliberate copying. "...[E]vidence of deliberate copying is relevant to a determination of secondary meaning." "Indeed, in appropriate circumstances, deliberate copying may suffice to support an inference of secondary meaning." Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837 (9th Cir. 1987), at Page 844.

The Court of Appeals stated in its Memorandum dispositon filed June 28, 1994 (Appendix D, Page d3): "...[E]ven if a trade dress theory had been timely raised, there is no

evidence raising a triable issue of fact on distinctiveness and seconday meaning - - which are indispensable elements."

Brown Bag has presented authority for the proposition that both distinctiveness and secondary meaning are not indispensable elements. Therefore, both elements need not be shown. Brown Bag discussed evidence of each in the alternative, including evidence of deliberate copying in support of seconday meaning.

III. THE "LOOK AND FEEL" OF A COMPUTER SOFTWARE PROGRAM IS A FORM OF TRADE DRESS PROTECTED UNDER LANHAM ACT SECTION 43(a), 15 U.S.C. SECTION 1125(a), FALSE DESIGNATION OF ORIGIN. BROWN BAG'S EVIDENCE OF TRADE DRESS INFRINGEMENT OF THE "LOOK AND FEEL" OF ITS COMPUTER SOFTWARE PROGRAM, PC-OUTLINE, WAS SUFFICIENT TO WITHSTAND SUMMARY JUDGMENT ON ITS LANHAM ACT CLAIM.

In its Memorandum disposition, the Court of Appeals stated (Appendix D, Page d4):

> Brown Bag's appeal is not wholly without merit as this court did remand for clarification on the Lanham Act claim and whether Brown Bag waived its trade dress infringement threory raises a colorable issue that is not entirely obvious.

Certainly, if Respondents did not state their motion with sufficient particularity under FRAP 7, then Brown Bag's trade dress claim is not waived.

PROCEEDINGS TO DATE

In Brown Bag, 960 F.2d 1465, The Court of Appeals stated at Page 1478:

> We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion.

The district court responded to this remand by holding a status conference on November 6, 1992. The district court stated at Page 6, Lines 11-13, of the status conference transcript that the court was going to listen to arguments briefly and make a ruling either requiring a new motion or merely clarifying the district court's previous order. Regarding the issue of evidence submitted by Brown Bag, the Company's attorney stated at transcript Page 7, Lines 17-21:

> I would like to say first that there was evidence for the Lanham Act on behalf of Brown Bag, and that's primarily based on the fact that look and feel evidence is appropriate evidence in a trade dress case.

Brown Bag's attorney went on to discuss at Pages 7-9 of the status conference transcript various evidence to prove Brown Bag's claim.

The district court granted Respondents' motions for judgment on Petitioner's Lanham Act Claim (Appendix B). The Court of Appeals affirmed (Appendix D).

TRADE DRESS

This is a case of first impression. There is no authority holding that the "look and feel" of a computer software program is a form of trade dress protected under Lanham Act Section 43(a), 15 U.S.C. 1125(a).

Computer software has grown into a major industry and has become an important segment of the U.S. economy. Computer software is an important export. The courts have struggled to adapt law to protect this important part of our economy. After certiorari was denied in Brown Bag, 960 F.2d 1465 (9th Cir. 1992), Symantec's attorney was quoted in The Wall Street Journal, Thursday, October 8, 1992, at Page A6, as follows:

> Mitchell Zimmerman, Symantec's attorney, said the Supreme Court's decision not to review the case will make it harder for other software companies to press "look and feel" copyright-infringement claims in the future.
>
> Mr. Zimmerman said the high court's decision was "an important emerging trend, lim-

iting the scope of copyright protection for computer programs."

Trade Dress Protection for "Look and Feel"

"Section 43(a) of the Lanham Act, 15 U.S.C. Section 1125(a), (footnote omitted) establishes a federal law of unfair competition by providing a statutory remedy to a party injured by a competitor's 'false designation or origin' of its product, whether or not the aggrieved party has a federally registered trademark." LeSportsac, Inc. v K Mart Corp., 754 F.2d 71 (2nd Cir. 1985) at Page 75. The LeSportsac court went on to state at Page 75 that the trade dress of a product may become an unregistered trademark eligible for protection under Section 43(a) and that the design of a product itself may function as its packaging, serving to distinguish it from other products, and hence be protectable trade dress under Section 43(a). The Supreme Court of the United States recently provided a comprehensive definition of trade dress. In Two Pesos, Inc. v. Taco Cabana, Inc., 505 US _, 120 L. Ed. 2d 615, 112 S. Ct. 2753 (1992). the Court stated at L.Ed. Page 621, Footnote 1:

> The District Court instructed the jury: "'[T]rade dress' is the total image of the business. Taco Cabana's trade dress may include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers' uniforms and other features reflecting on the total image of the restaurant." 1

App 83-84. The Court of Appeals accepted this definition and quoted from Blue Bell BioMedical v. Cin-Bad, Inc., 864 F2d 1253, 1256 (CA5 1989): "The 'trade dress' of a product is essentially its total image and overall appearance." See 932 F2d 1113, 1118 (CA5 1991). It "involves the total image of a product and may include features such as size, color or color combinations, texture, graphics, or even particular sales techniques." John H. Harland Co. v. Clarke Checks, Inc. 711 F2d 966,980 (CALL 1983). Restatement (Third) of Unfair Competition Section 16, Comment a (Tent. Draft No. 2, Mar. 23, 1990).

McCarthy on Trademarks and Unfair Competiton, J. Thomas McCarthy (hereinafter "J. McCarthy"), Third Edition, Volume 1, states at Pages 8-4 and 8-5 that traditionally, trade dress was thought to consist only of the appearance of labels, wrappers and containers used in packaging the product. He continues by stating that in modern parlance, trade dress includes the total look of a product and its packaging and even includes the design and shape of the product itself. J. McCarthy states on Page 8-8 that the field of law once referred to as unfair competition by "product simulation," has now folded into that corner of trademark and unfair competition law called "trade dress." On Page 8-5, J. McCarthy says: "Trade dress encompasses the total image or overall impression created by a product or its packaging." J. McCarthy states on Page 8-5, 8-6, and 8-7:

> "Trade dress" is an expansive concept, and has been held to include such things as: the cover of a book; a magazine cover design; the appearance of a teddy bear toy; a Rubik's

cube puzzle; the shape of a classic automobile; the overall design of a sports shoe; the appearance of a video game console; a combination of features of a folding table; the decor, menu and style of a restaurant; and the distinctive performing style of rock music group. (Citations omited.)

Trade dress protection has even been streched to include protection of the overall "look" of a line of greeting cards. Individual features making up the "look" included such common items as a two-fold card, deckle edge, lengthy poety and air brush colors. In that case, the Tenth Circuit said: "[T]he arbitrary selection and combination of greeting card features may constitute protected trade dress even though the features serve useful purposes in conveying messages and invoking certain emotions and feelings. Hartford House, Ltd. v. Hallmark Cards, Inc. 647 F. Supp. 1533, 1 USPQ2d 1030 (D.C. Colo. 1986), aff'd, 846 F.2d 1268, 6 USPQ2d 2038 (10th Cir. 1988). See Ruolo v. Russ Berrie & Co., 886 F.2d 931, 12 USPQ2d 1423 (7th Cir. 1989), reh. denied, 1989 U.S. App. LEXIS 19156 (7th Cir 1989) and cert. denied, 493 U.S. 1075, 107 L.Ed.2d 1030, 110 S.Ct. 1124 (1990) ("Trade dress encompasses the overall appearance of a product, including its size, color or color combination, texture, graphics, packaging or other visual features." The overall combination of individually "common, indistinct elements" making up a line of greeting cards was protected as trade dress and a $4.3 million award was affirmed.).

In Midway Mfg. Co. v. Dirkschneider, 543 F.Supp. 466 (U.S.D.C.,D. Nebraska 1981), Midway Mfg. Co. ("Midway") a manufacturer of coin-operated electronic video games brought an action alleging that the defendants were

engaged in the manufacture, distribution, and sale of video games which were vertually identical to the Plaintiff's Galaxian, Pac-Man and Rally-X games. Midway contended that the conduct of the defendants infringed Midway's copyrights and violated the Lanham Act as well as a state statute. Preliminary injunctions issued under both copyright and Lanham Act causes of action. The design features examined by the court under the Lanham Act claim were the numerous characters which were found in Midway's games. Midway Mfg. Co., 543 F.Supp. 466, at Page 485. The Midway court examined not only the similarity of the design features but also manner of operation of the games. The Midway court stated at Page 488:

> The risk of confusion created by the striking similarity of the design features is exacerbated by the manner in which these games operate. (Footnote omitted.) Each of the parties' games has an attract mode, which is a display continuously shown on the cathode ray rube whenever the game is attached to a power source and not in the play mode. The attract mode is designed to entice passerby into playing the game. The game's characters are prominently displayed in the attract mode.
>
> The attract modes of the plaintiff's and defendents' games are identical in their overall appearance. The attract modes of the defendant's games imitate not only the design features of the plaintiff's game characters but also the plaintiff's manner of presenting these characters. For example, in both the plaintiff's Pac-Man game and the defendants' Mighty Mouth game, the attract modes feature the game characters and their nicknames in a vertical column. Although the names

> given the characters in defendant's games are different from plaintiff's, the general impression created by the presentation is the same. After the characters are introduced, a number of them engage in a chase underneath the column of characters and nicknames. This chase is identical in both games.

In United States Gold Ass'n v. St. Andrews Systems, 749 F.2d 1028 (3rd Cir. 1984), an amateur golf organization brought an action to enjoin a computer comany from using its mathematical "handicapping" formula as the basis for a computerized handicap system. The court did not state that trade dress protection would not apply per se to a "handicapping" formula but performed an analysis and stated at Page 1034:

> The U.S.G.A. formula is like an "industry standard": it allows the handicaps calculated by different providers to be compared with one another, much as the standard gauge of railroad track allows a locomotive of one company to run on the track of another. Allowing one provider to obtain exclusive rights in such a standard would enable it to exclude competitors desiring to provide the same product or service, particularly if the original provider, such as the U.S.G.A. in this case, starts with a virtual monopoly. To allow a monopoly over such a standard would defeat the policy of fostering competition that underlies the functionality doctrine.

Romm Art Creations Ltd. v. Simcha International Inc., 22 USPQ2d 1801 (District Court, E.D. New York 1992) applied trade dress protection to works of art. The Romm court held at Page 1806 that "...[T]he Tarkay posters and

limited editions are entitled to protection under Section 1125(a) of the Lanham Act." The Romm court stated at Page 1806:

> This court finds most persuasive the decision in Hartford House Ltd. v. Hallmark Cards Inc., 647 F.Supp. 1533 [1 USPQ2d 1030] (D. Colo. 1986), aff'd, 846 F.2d 1268 [6 USPQ2d 2038] (10th Cir.), cert denied, 488 U.S. 908 (1988). In Harford House, a small commercial manufacturer of "non-occasion" greeting cards which conveyed emotional messages about personal relationships brought suit agianst Hallmark, alleging that its "Personal Touch" line of cards infringed the plaintiff's product. In finding that the Lanham Act was applicable in this type of situation, the district court stated the following:
>
> > "[O]ne salutary purpose of the Lanham Act in this context is to protect a creative artist's right in his or her creation and thus provide incentive to be creative. By protecting and fostering creativity, a product with features differenct and perhaps preferaable to the Blue Mountain product may well be developed. Offering consumers a choice in the non-occasion greeting card market stimulates, rather than stifles competition" (Hartford House, 647 F.Supp. at p.1540).
>
> On appeal, the Tenth Circuit held that the district court was correct in determining preliminary that the combination of the features comprising the trade dress (i.e. the overall appearance or look of Blue Mountain's "Aire-Brush Feelings" and "WaterColor Feelings" cards) is not functional and was thus protectable under Section 43(a) of the Lanham Act. (Citation ommitted.)

Thus, this is a case of first impression. There is no case holding whether the "look and feel" of a computer software program is a form of trade dress subject to protection under Lanham Act Section 43(a), 15 U.S.C. Section 1125(a). However, there are cases which hold that a variety of other products have been afforded trade dress protection. This Court now has the opportunity to extend much-needed trade dress protection to a computer software program.

THE LAW

"The Lanham Act was intended to make 'actionable the deceptive and misleading use of marks' and 'to protect persons engaged in ... commerce against unfair competition.'" (Footnote and citation omitted.) Two Pesos, Inc, v. Taco Cabana, Inc., 505 US __, 120 L. Ed. 2d 615, 112 S. Ct. 2753 (1992) at L. Ed. Page 623. "... Section 43(a) provides no basis for distinguishing between trademark and trade dress. Two Pesos, 120 L.Ed 2d 615, at L. Ed. Page 626. "Protection of trade dress, no less than of trademarks, serves the Act's purpose to 'secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers." Two Pesos, at L. Ed. Page 627.

Trade dress and the criteria for trade dress protection are set forth in Two Pesos, 120 L. Ed. 2d 615. The three basic requirements are discussed in Two Pesos, at Page 624. First, the trade dress must be inherently distinctive or have acquired distinctiveness through secondary meaning. The court held

in Two Pesos at Page 628 that proof of secondary meaning is not required to prevail on a claim under Lanham Act Section 43(a) where the trade dress at issue is inherently distinctive. Second, protection also depends on nonfunctionality. Third, liability requires proof of the likelihood of confusion. Each of these factors will be discussed in more detail.

Inherently Distinctive. Inherently distinctive trade dress is capable of identifying products or services as coming from a specific source. Two Pesos, 120 L Ed 2d 615, at Page 627. Trade dress which is suggestive, arbitrary or fanciful is deemed to be inherently distinctive and entitled to protection because its intrinsic nature serves to identify a particular source of a a product. Two Pesos, at Page 623 and 624. Arbitrary or uncommon trade dress might qualify as inherently distinctive. Fuddruckers, Inc. v. Doc's B.R. Others, Inc. 826 F.2d 837 (9th Cir. 1987).

Secondary Meaning. Secondary meaning is used generally to indicate that a trade dress has come through use to be uniquely associated with a specific source. "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." (Citations omitted.) Two Pesos, 120 L. Ed. 2d. 615, at Page 622, Footnote 4. "...[E]vidence of deliberate copying is relevant to a determination of secondary meaning." "Indeed, in appropriate circumstances, deliberate copying may suffice to support an inference of secondary

meaning." Fuddruckers, 826 F.2d 837, at Page 844. In M. Kramer Mfg. Co., Inc. v. Andrews, 783 F.2d 421 (4th Cir. 1986), the court stated at Page 448:

> We hold that evidence of intentional, direct copying establishes a prima facie case of secondary meaning sufficient to shift the burden of persuasion to the defendant on that issue, and since the defendants have offered no credible evidence rebutting this presumption, the infringement is established.

Functionality. "Only nonfunctional, distinctive trade dress is protected under Section 43(a)." Two Pesos, 120 L. Ed 615, at Page 627.

A. In Two Pesos, 120 L Ed 2d 615, at Pages 627 and 628, the Court endorsed the holding of the Court of Appeals below:

> The Fifth Circuit holds that a design is legally functional, and thus unprotectable, if it is one of a limited number of equally efficient options available to competitors and free competion would be unduly hindered by according the design trademark protection. This serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dressess.

B. In Fuddruckers, 826 F.2d 837, at Page 842, The Court of Appeals discussed functionality. "A product feature is functional if it is essential to the product's use or if it affects the cost or quality of the article." The "ultimate inquiry in functionality analysis is whether protecting a feature will

hinder competition." [F]unctional elements that are separately unprotectable can be protected together as part of a trade dress." The "...inquiry is not addressed to whether individual elements of a trade dress fall within the definition of functional, but to whether the whole collection of elements taken together are functional." One cannot prevent others from using any particular color or feature, but can protect a combination of visual elements "that, taken together, ...may create a distinctive visual impression." (Citations and footnote omitted.) Fuddruckers, 826 F.2d 837, at Page 842. In the instant case, the Purchase and Sale Agreement, at Page 6, licensed certain cource code to Mr. Friend on a non-exclusive basis. The Purchase and Sale Agreement is attached to Brown Bag's Complaint. The pages of source code were attached to the Purchase and Sale Agreement. The district court in its copyright infringement analysis redacted the material which was licensed to Mr. Friend. Brown Bag, 12 USPQ2d 1991, at Page 1996. Such materal should be included in the trade dress analysis being conducted by this Court because the Purchase and Sale Agreement states at Pages 6 and 7: "Nothing in this Agreement will be construed as ...any implied right to use the "look and feel" of the Program..."

C. In Dallas Cowboys, Etc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2nd Cir. 1979), the court stated at Page 204:

> Thus, the fact an item serves or performs a function does not mean that it may not at the same time be capable of indicating sponsorship or origin, particularly where the decora-

> tive aspects of the item are nonfunctional. (Citations omitted.) In the instant case the combination of the white boots, and star-studded vest and belt is an arbitrary design which makes the otherwise functional uniform trademarkable. (Footnote 6).

D. The Ninth Circuit has placed the burden of proof for functionality on the plaintiff. The plaintiff must show that its trade dress is nonfunctional. Rachel v. Banana Republic, Inc., 831 F.2d 1503 (9th Cir. 1987), at Page 1506. In Footnote 2 on Page 1506, the Rachel Court discusses the rule elsewhere. The Rachel Court states in Footnote 2: "The weight of authority, however, treats functionality as a defense." "Requiring the plaintiff to prove nonfunctionality in order to prevail might 'defeat' the Lanham Act's purpose of enabling a purchaser to distinguish one product from another, see S. Rep. No. 1333 [79th Cong., 2d Sess. 4 (1947)], because a plaintiff unable to prove that the features copied are nonfunctional will not prevail, no matter how compelling the evidence that purchasers are confused as to product source.' LeSportsac, Inc. v. K Mart Corp., 754 F.2d71, (2nd Cir. 1985), at Page 76. THIS COURT MAY FEEL THAT THIS ARGUMENT HAS MERIT AND WISH TO CONSIDER STANDARDIZING THESE RULES WHICH DIFFER AMONG THE CIRCUITS.

Likelihood of Confusion. "The test is whether there is likelihood of confusion resulting from the total effect of the defendant's product and package on the eye and mind of an ordinary purchaser." First Brands Corp., v. Fred Meyer, Inc., 809 F.2d 1378 (9th Cir. 1987), at Pages 1383 and 1384.

"Likelihood of confusion 'exists when customers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product of service identified by a similar mark.'" "The public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement." Dallas Cowboys, Etc., 604 F.2d 200, at Page 205. "The factual elements that make up likelihood of confusion evidence of actual confusion, the defendant's intent in adopting the mark, similarity of marks, similarity of goods and marketing channels, and the strength of the mark." "Evidence of actual confusion is persuasive proof that future confusion is likely." As showing that the defendant intended to adopt the plaintiff's trade dress is also 'entitled to great weight because a defendant is presumed able to accomplish this purpose.'" "[C]ourts almost unanimously presume a likelihood of confusion based on a showing of intentional copying." (Citations and footnote omitted.) Fuddruckers, 826 F.2d 837 at Pages 845 and 846. "Finally, intent of a defendant in adopting his trade dress is a critical factor, since if the trade dress were adopted with the intent of depriving benefit from the reputaion of the plaintiff, the fact alone may be sufficient to justify the inference that there is confusing similarity." First Brands, 809 F.2d 1378, at Page 1385. In Eclipse Associates Ltd. v. Data General Corp., 894 F. 2d 1114 (9th Cir. 1990), The Court of Appeals discussed the 5-factor test and the 8-factor test. "The Ninth Circuit has made no firm distinction between the 5 factor and 8 factor tests for likelihood of confuction in trademark infringment cases." "In

some cases, the first test is used, in others the second is used." Eclipse Associates, 894 F.2d 1114, at Page 1117. In Eclipse Associates, The Court of Appeals stated at Page 1118:

> The Ninth Circuit enumerated likelihood of confusion tests as helpful guidelines to the district court. These tests were not meant to be requirements or hoops that a district court need jump through to make a determination. Our court has never articulated specific factors that a district court must recite and apply, instead, we have identified a non-exclusive series of factors that are helpful in making the ultimate factual determination.

The Evidence.

Overview. The following is an overview of the evidence by the elements required to show a Lanham Act Section 43(a) trade dress case:

A. The district court entertained an in-court demonstration of the two programs and carefully reviewed submitted copies of relevant outlining programs. Brown Bag, 12 USPQ2d 1991, at Page 1992.

B. Declaration of Sanford B. Schupper, filed June 8, 1988.

C. Declaration of Sanford B. Schupper, executed on April 7, 1989. Exhibit 1 to "Plaintiff's Opposition to Both

Defendants' Motions for Summary Judgment," filed April 19, 1989.

D. Attachment 1 to Mr. Schupper's Declaration of April 7, 1989 is a true copy of the Cover and Pages 126 and 127 of the Grandview User's Guide. These pages state that PC-Outline files may be moved into GrandView.

E. Attachments 2 through 6 to Mr. Schupper's Declaration of April 7, 1989 are photographs of various PC-Outline and GrandView screen displays.

F. Attachment 7 to Mr. Schupper's Declaration of April 7, 1989 is a true copy of an article entitled "High-Priced GrandView Programs Inadequate for Many Office Needs," by Mark J. Welch and Barry D. Bayer, published in The Recorder on June 14, 1988, beginning at or about Page 4 Mr. Welch states: "GrandView has the same 'look and feel' as PC-Outline..."

G. Attachment 8 to Mr. Schupper's Declaration of April 7, 1989 is a true copy of an article entitled "Outliners Can't Think For You But Can Organize Your Thoughts" by Jim Bartimo, Computing Editor, published in The San Jose Mercury News during 1988. Mr. Bartimo appears to believe that GrandView is nothing more than an upgrade of PC-Outline. Mr. Bartimo states: "Because Symantec recently purchased the maker of ThinkTank and hired the programmer of another popular outliner, PC-Outline, GrandView is the logical upgrade to both of those programs."

H. Declaration of Mr. Ronald Ogg, Exhibit 2 to "Plaintiff's Opposition to Both Defendant's Motion for Summary Judgment," filed April 19, 1989.

I. Deposition of John L. Friend, October 18, 1988, Page 110, Exhibit 3 to "Plaintiff's Opposition to Both Defendants' Motions for Summary Judment," filed April 19, 1989.

J. Declaration of John L. Friend in Opposition to Motion for Preliminary Injunction, filed June 24, 1988, Pages 1, 2 and 9.

K. Supplemental Declaration of John Friend in Support of Motion for Summary Judgment, filed May 19, 1989.

L. Declaration of Alice Lankester In Opposition to Motion for Preliminary Injunction, filed June 24, 1988, Pages 1-10.

M. Declaration of William R. Hershey in Opposition to Motion for Preliminary Injunction, filed June 24, 1988. Attached to Mr. Hershey's Declaration as Exhibit A is a copy of his article entitled Outliners which he declares that he has submitted for publication to the Encyclopedia of Computer Science and Technology and the Encyclopedia of Microcomputers.

N. Declaration of Victoria Case In Support of Proctective Order Against Disclosure of Defendant's Source Code and

Other Highly Confidential Information to Plaintiff's In-House Counsel, Executed March 2, 1989.

O. Deposition of Sanford B. Schupper, Volume II, Friday, September 23, 1988, of which the Cover Page and Pages 244, 245, 270, 278, 279 and 311 are included as Exhibit A to the Declaration of Mitchell Zimmerman In Support of Defendant Symantec Corporation's Reply Memorandum.

Brown Bag's brief at the Court of Appeals applied the foregoing evidence to the Trade Dress (False Designation of Origin) cause of action.

CONCLUSION

For these reasons, a writ of certiorari should issue to review the judgment and opinion of the Court of Appeals in this matter. Petitioner respectfully suggests that this Honorable Court consture the paramters of FRCP 7's requirments for particularity and, in so doing, hold that the moving parties in the instant case did not furnish that particularity. Petitioner futher respectfully requests that this Honorable Court confirm that distinctiveness and secondary meaning are not both indispensable elements of a trade dress cause of action.

Finally, Petitioner respectfully requests that this Honorable Court decide whether the "Look and Feel" of a computer software program is a form of trade dress protected under Lanham Act Section 43(a), 15 U.S.C. Section 1125(a), False Designation of Origin.

Dated: October 7, 1994

Respectfully Submitted,

Brian Flynn
Attorney for Petitioner
P.O. Box 61704
Sunnyvale, CA 94088
Phone: (415) 965-5178

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APPENDIX A

BROWN BAG SOFTWARE V. SYMANTEC CORP.

960 F.2d 1465 (9th Cir. 1992)

Pages 1477 and 1478

Section III. Brown Bag's Federal Trademark/Trade Dress Claim

III. *Brown Bag's Federal Trademark/Trade Dress Claim*

[20,21] In its complaint, Brown Bag alleged two federal claims, copyright infringement and "false designation of origin," a violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). For its Lanham Act Claim, Brown Bag alleges that "Defendants ... falsely promote Grandview as being an upgrade, derivative or improvement upon PC-Outline in a manner to suggest a connection with [Brown Bag] ... There is A likelihood of confusion, mistake or deception."[6] [Complaint at 9, ER at F.]

[22] The district court dismissed Brown Bag's pendent state claims because it had granted summary judgment to Symantec and Friend on Brown Bag's federal claims. The district court's order granting summary judgment does not even mention the Lanham Act claim, however. If the district court intended to grant summary judgment on the Lanham Act claim as well, its order granting summary judgment on the infringement claim presents no rationale for it. On this record, it appears that the district court intended to dispose of all federal claims on summary judgment, but overlooked the Lanham Act claim.

Symantec argues that we should infer the district court intended to grant summary judgment on the Lanham Act claim and affirm that judgment on the basis of the record. In support of its motion for summary judgment, Symantec informed the district court that there was "no evidence that Symantec or its agents falsely promoted Grandview ... in [a] manner as to suggest a connection with [Brown Bag]." In response, Brown Bag failed to offer any evidence pertaining to the Lanham Act claim, and therefore failed to carry its evidentiary burden in opposing summary judgment. *See* Fed.R.Civ.P. 56(c); *Shaw*, 919 F.2d at 1359. Because the evidence of record is one-sided in favor of Symantec, Symantec argues that we should infer and affirm the district court's summary judgment for Symantec on the Lanham Act claim.

Symantec's argument is pragmatic, assuring as it would a final end to the litigation given that Brown Bag's other claims of error are without merit. Symantec asks the court, however, to infer a district court's decision on the entire claim and to rewrite a district court judgment to include the inferred decision. We decline to take such liberties with a district court's intentions and judgment. Instead, we conclude that it was Symantec's and Friend's responsibility to clarify the district court's judgment and to save themselves needless litigation over a possible oversight. We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion.

6. The claim which Brown Bag alleges is a Lanham Act false designation of origin claim, distinguishable from a "reverse passing off" claim. In a "reverse passing off" claim under the Lanham Act, a defendant markets a copied product as its own. *See Shaw*, 919 F.2d at 1364. A reverse passing off claim is therefore dependent upon a successful infringement claim. *Id.* (declining to recognize reverse passing off claims in all events). Because Brown Bag alleged in its complaint a false designation of origin claim, however, Brown Bag need not have shown that Symantec and Friend infringed Brown Bag's copyright in PC-Outline in order to state a claim under the Lanham Act that Symantec and Friend falsely promoted Grandview as an updated version of PC-Outline. Summary judgment on Brown Bags copyright infringement claim, therefore, did not compel summary judgment on its Lanham Act claim.

APPENDIX B

ORDER GRANTING SUMMARY JUDGMENT OF PLAINTIFF'S LANHAM ACT CLAIM, FILED NOVEMBER 12, 1992

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

BROWN BAG SOFTWARE, INC. a California corporation, Plaintiff, v. SYMANTEC CORP-ORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development, Defendants.	Case No. C 88 20352 RPA ORDER GRANTING SUMMARY JUDGMENT ON PLAINTIFF'S LANHAM ACT CLAIM

On September 7, 1989 this Court granted Defendant's motion for summary judgment on Plaintiff's copyright infringement claim but did not expressly rule on Plaintiff's trademark claim under the Lanham Act. By separate order of September 7, 1989 the Court noted that no federal law claims remained in the suit, declined to exercise pendent jurisdiction and dismissed Plaintiff's remaining state law claims.

Plaintiff appealed the court's summary judgment. On April 7, 1992 the Ninth Circuit affirmed and remanded to this

court for clarification and further proceedings as the district court deemed necessary, the issue of Plaintiff's federal trademark claim.[1]

The Court has reviewed the Ninth Circuit's opinion, the papers submitted and the case file. A status conference was held on November 6, 1992 at which this Court's prior ruling was discussed. Although not stated expressly in its previous order granting summary judgment, the Court has intended to grant summary judgment on all federal claims, i.e. the trademark claim as well as the copyright infringement claim. This order amends and clarifies the previous summary judgment and GRANTS Defendants' motion for summary judgment on the trademark claim under the Lanham Act for false designation of origin. 15 U.S.C. § 1125(a).

The Court's decision is based on the following: In the moving papers, Defendant John L. Friend specifically reviewed the Lanham Act claim and the lack of evidence to support such a claim. Defendant Symantec included the false designation of origin claim in its discussion of summary judgment for the state law claims. However, in its opposition, Plaintiff presented no evidence in support of its claim for false designation of origin. In fact Plaintiff did not even mention the Lanham Act in its opposition brief.

---

[1]The United States Supreme Court denied plaintiff's petition for writ certiorari on October 5, 1992.

Defendants have met their burden of "'showing' -that is, pointing out to the district court- that there is an absence of evidence to support the nonmoving party's case." Celotex Corp. v. Catrett, 477 U.S. 317, 325 (1986). Summary judgment is therefore appropriate. Fed. R. Civ. P. 56 (c).

Good Cause Appearing therefor, Defendants' motion for summary judgment on Plaintiff's Lanham Act Claim is hereby GRANTED.

IT IS SO ORDERED.

DATED: November 10, 1992

/Signed/
ROBERT P. AGUILAR
United States District Judge

COPIES MAILED ON NOVEMBER 12, 1992 TO:

For Plaintiff:

William Green
Law Offices of William Green & Assoc.
550 Hamilton Avenue, Suite 320
Palo Alto, CA 94301

Brian Flynn
2155 South Bascom Avenue, Suite 114
Campbell, CA 95008

For Defendant:

Mitchell Zimmerman
Fenwick, Davis & West
Two Palo Alto Square, Suite 800
Palo Alto, CA 94306

Paul L. Warner
Jeffer, Mangels, Butler & Marmaro
One Sansome Street, 12th Floor
San Francisco, CA 94104

APPENDIX C

JUDGMENT NUNC PRO TUNC, FILED NOVEMBER 24, 1992

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

BROWN BAG SOFTWARE, INC. a California corporation,	}	Case No. C 88-20352 RPA
Plaintiff,	}	JUDGMENT NUNC PRO TUNC
v.	}	
SYMANTEC CORP-ORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development,	}	
Defendants.	}	

By Order of November 12, 1992 and pursuant to the Ninth Circuit's April 7, 1992 opinion remanding plaintiff's federal trademark claim for clarification, the Court clarified its previous order of September 7, 1989 by expressly granting summary judgment on plaintiff's trademark claims. Pursuant to the Order of November 12, 1992 Granting Summary Judgment on Plaintiff's Lanham Act Claim, Judgment is

APPENDIX D

MEMORANDUM DISPOSITION, FILED JUNE 28, 1994

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

(DISTRICT COURT'S JUDGMENT ON BROWN BAG SOFTWARE'S CLAIM FOR FALSE DESIGNATION OF ORIGIN UNDER LANHAM ACT AFFIRMED.)

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

BROWN BAG SOFTWARE, Plaintiff Appellant, v. SYMANTEC CORP.; JOHN L. FRIEND, Defendants-Appellees	Case No. 92-17119 D.C. No. CV-88-20352-RPA MEMORANDUM*

Appeal from the United States District Court for the Northern District of California
Robert P. Aguilar, District Judge, Presiding

Argued and Submitted June 16, 1994
San Francisco, California

Before: GOODWIN, PREGERSON, and RYMER, Circuit Judges.

Brown Bag Software appeals the district court's grant of summary judgment on its claim for false designation of orgin

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* This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by 9th Cir. R. 36-3.

under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). We have jurisdiction, 28 U.S.C. § 1291, and we affirm.

I

On remand from this court for clarification of its earlier summary judgment ruling, the district court stated that "[i]t was my intention to grant summary judgment with respect to all the federal claims including the . . . claim for false designation of origin . . . " It then entered judgment on that claim nunc pro tunc.

Even though Brown Bag argues that it didn't realize summary judgment was being sought on its Lanham Act claim, Symantec's notice of motion indicates that it sought judgment on all claims; moreover, the grounds offered in support include the absence of evidence that Symantec falsely promoted GrandView as being an upgrade, derivative, or improvement upon PC-Outline, tracking exactly Brown Bag's fourth claim for relief. Brown Bag attempts to avoid this ruling by arguing that the overall "look and feel" of its software program is protectible trade dress under § 43(a). This argument fails because the issue was raised after the record on summary judgment was closed, Brown Bag's opposition to summary judgment contains neither argument nor evidence pertaining to its claim for false designation of origin, and even if a trade dress theory had been timely raised, there is no evidence raising a triable issue of fact on distinctiveness and secondary meaning - - which are indispensable elements. Once the moving party demonstrates "that there

is an absence of evidence to support the nonmoving party's case," the nonmoving party must "come forward with all of her evidence" to avoid summary judgment. Celotex Corp. v. Catrett, 477 U.S. 317, 325-26 (1986). Based on the evidence the district court had before it, the grant of judgment nunc pro tunc in favor of Symantec and Friend was proper.

II

Symantec asks for attorney's fees and double costs on the ground that Brown Bag's appeal is frivolous. See Fed. R. App. P. 38. "A frivolous appeal is defined as one in which the result is obvious, or where the appellants' claims are utterly meritless." Harrah's Club v. Van Blitter, 902 F.2d 774, 777 (9th Cir. 1990). Brown Bag's appeal is not wholly without merit as this court did remand for clarification on the Lanham Act Claim and whether Brown Bag waived its trade dress infringement theory raises a colorable issue that is not entirely obvious.

Brown Bag also asks that all briefs submitted by Fenwick & West be stricken, the present appeal be decided in Brown Bag's favor, and that we reconsider our earlier decision in Brown Bag Software v. Symantec Corp., 960 F.2d 1465 (9th Cir.), cert. denied, 113 S. Ct. 198 (1992), on the ground that the firm's continued representation of Symantec poses a conflict of interest because Brown Bag's counsel joined Fenwick while an appeal in this action was pending. Brown Bag does not want Fenwick disqualified; the relief that it seeks - - striking all Fenwick briefs and deciding the appeal

in Brown Bag's favor - - is unprecedented and unwarranted on the record.

AFFIRMED.

APPENDIX E

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT ORDER FILED JULY 28, 1994

(APPELLANT'S PETITION FOR REHEARING DENIED)

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

BROWN BAG SOFTWARE, Plaintiff-Appellant, v. SYMANTEC CORP.; JOHN L. FRIEND, Defendants-Appellees	Case No. 92-17119 D.C. No. CV-88-20352-RPA ORDER

Before: GOODWIN, PREGERSON, and RYMER, Circuit Judges.

Appellant's Petition for Rehearing in DENIED.

APPENDIX F

RESPONDENT SYMANTEC CORPORATION'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT, FILED APRIL 4, 1989, PAGE 38, SECTION IV

IV. TELEMARKETING'S PENDANT STATE CLAIMS ARE DEPENDENT ON ITS COPYRIGHT INFRINGEMENT CLAIMS AND ARE BASELESS.

Telemarketing's pendant state claims against Symantec -- false designation of origin and unfair competition - - are inextricably tied to its copyright infringement claim. Since the copyright infringement claim is lacking in substance, the related pendant state claims have no basis either.

Pursuant to the United States Supreme Court's holding in Celotex Corp. v. Catrett, supra, 477 U.S. 317, 325 defendant Symantec is not obliged to come forward with evidence to negate the elements of plaintiff's state law claims, so long as the moving party "point[s] out to the district court . . . that there is an absence of evidence to support the nonmoving party's case." Symantec hereby does so with regard to the pendant state claims. [24/]

///

[24/] Symantec contends that there is no evidence to sustain the allegations that Symantec has engaged in unfair competition other than the claim (if it were sufficient) that Symantec infringed plaintiff's copyright. Symantec further contends that there is no evidence to sustain the allegations that Symantec or its agents falsely promote Grandview as being an upgrade, derivative or improvement upon PC-Outline in a manner as to suggest a connection with plaintiff, nor is there any evidence that the advertising,

marketing or promotion of Grandview is such that consumers are led to believe it comes from the same source as PC-Outline, nor is there evidence that plaintiff has ever lost any profits or suffered any other damage in its sales of PC-Outline due to the supposed wrongs of defendants.

APPENDIX G

RESPONDENT JOHN L. FRIEND'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT, FILED MARCH 31, 1989, PAGE 23 AND PAGE 24, SECTION C

C. False Designation of Origin (Fourth Claim)

In this claim, plaintiff contends that defendants falsely promote Grandview as being an upgrade, derivative or improvement upon PC-Outline in violation of Section 43(a) of the Lanham Act. Complaint, ¶ 33. The elements of a Section 43(a) claim are: (1) a false statement of fact about products in advertisements: (2) a tendency of deceive numerous consumers through the false advertisements; (3) such deception is material and likely to influence the purchasing decision; (4) the falsely advertised goods are in interstate commerce; and (5) the plaintiff has been injured as a result of the ads. U-Haul International, Inc. v. Jartran, Inc., 522 F. Supp. 1238 (D. Ariz. 1981), aff'd, 681 F.2d 1159 (9th Cir. 1982). Plaintiffs fail even to allege at all the fourth element. See, Complaint, ¶ 33.

Moreover, plaintiff has failed to provide any evidence showing false advertisements (first element) or the tendency to deceive numerous consumers (second element). When asked in Interrogatory No. 31 to state the facts on which this contention is based, Telemarketing responded: "Symantec offers Grandview to PC-Outline owners at a drastically reduced price. Grandview can even accept PC-Outline files. John Friend even said on Compuserve, 'once PC-Outline users use Grandview, they'll never look back.'" Nothing in this response even remotely suggests that defendants made any false statement in advertisements. Even if plaintiff's

allegations were viewed as somehow suggesting a false advertisement, there is no evidence to support these claims. Indeed, plaintiff is unable to show that defendants are promoting Grandview as being connected with or derivative of PC-Outline.

APPENDIX H

FEDERAL RULES OF CIVIL PROCEDURE

28 U.S.C. RULE 7

FEDERAL RULES OF CIVIL PROCEDURE

28 U.S.C. RULE 7

Rule 7. Pleadings Allowed; Form of Motions

(a) Pleadings. There shall be a complaint and an answer; a reply to a counterclaim denominated as such; an answer to a cross-claim, if the answer contains a cross-claim; a third-party complaint, if a person who was not an original party is summoned under the provisions of Rule 14; and a third-party answer, if a third-party complaint is served. No other pleading shall be allowed, except that the court may order a reply to an answer or a third-party answer.

(b) Motions and Other Papers.

(1) An application to the court for an order shall be by motion which, unless made during a hearing or trial, shall be made in writing, shall state with particularity the grounds therefor, and shall set forth the relief or order sought. The requirement of writing is fulfilled if the motion is stated in a written notice of the hearing of the motion.

(2) The rules applicable to captions and other matters of form of pleading apply to all mo-

tions and other papers provided for by these rules.

(3) All motions shall be signed in accordance with Rule 11.

(c) Demurrers, Pleas, etc. Abolished. Demurrers, pleas, and exceptions for insufficiency of a pleasing shall not be used.

APPENDIX I

15 U.S.C. 1125(A)

15 U.S.C. § 1125(a)

§ 1125. False designations of origin and false descriptions forbidden

(a) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact which --

> (1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, or commercial activities by another person, or
>
> (2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Supreme Court, U.S.
FILED
NOV 14 1994
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No. 94-683

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1994

BB ASSET MANAGEMENT, INC., Transferee
Through Brown Bag Software, Inc.
Petitioner

vs.

SYMANTEC CORPORATION and JOHN L. FRIEND,
an individual and dba SOFTWORKS DEVELOPMENT
Respondents

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

OPPOSITION BRIEF OF RESPONDENT SYMANTEC CORPORATION

MITCHELL ZIMMERMAN
FENWICK & WEST
Two Palo Alto Square, 8th Floor
Palo Alto, California 94306
Telephone: (415) 494-0600
Counsel for Respondent
Symantec Corporation

QUESTIONS PRESENTED

1. Notice That Summary Judgment Was Sought:

A. Should this Court grant certiorari to consider whether respondents' summary judgment motion "state[d] the *grounds* for [summary judgment] with sufficient particularity,"[1] when petitioner Brown Bag never placed that issue before the Ninth Circuit, having instead asked the Ninth Circuit to decide whether Brown Bag "didn't realize summary judgment was being sought on its Lanham Act claim"?[2]

B. Did Brown Bag have notice that defendants were seeking summary judgment against the False Designation of Origin/Lanham Act claim when:

- Both moving parties' notices of motion unequivocally stated that defendants were moving for summary judgment on *all* of Brown Bag's claims;
- Moving defendant Friend's memorandum in support of summary judgment contained a section titled "False Designation of Origin (Fourth Claim)"; and
- Moving defendant Symantec's memorandum expressly recited all of the factual allegations of the Lanham Act claim and specifically contended that there was no evidence to support any of them?

2. Waiver: Can Brown Bag's substantive contentions regarding its "trade dress" claim be considered on the merits when:

---

1 Petition for Writ of Certiorari ("Petition" or Pet."), p. i, emphasis added.

2 Ninth Circuit Memorandum filed June 28, 1994 ("Ninth Cir. Mem."), App. p. d3.

(a) Brown Bag unambiguously waived the claim in the district court by failing to mention or argue in favor of the Lanham Act claim in response to the summary judgment motions;

(b) the Ninth Circuit squarely held that the trade dress issue was waived because "the issue was [first] raised after the record on summary judgment was closed, [and] Brown Bag's opposition to summary judgment contains neither argument nor evidence pertaining to its claim for false designation of origin";[3] and

(c) any decision on the merits of the trade dress issue would be moot since Brown Bag has not asked this Court to review the Ninth Circuit's holding that the claims were waived?

*3. **Distinctiveness Standard:*** Did the Ninth Circuit err in holding that Brown Bag's failure to offer evidence of inherent distinctiveness and failure to offer evidence of secondary meaning would have doomed the trade dress claim even if it had been timely raised?

*4. **"Look and Feel" as Trade Dress:*** Is this case a suitable vehicle for considering the contention that the overall "look and feel" (whatever that may mean) of a computer program constitutes trade dress where Brown Bag failed to introduce the entire programs into evidence, never so much as uttered the words "trade dress" in the district court, created no relevant record, and proffered no evidence of essential elements of a trade dress claim?

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3 *Id.*

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Respondents

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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BRIEF IN OPPOSITION OF RESPONDENT SYMANTEC CORPORATION

INTRODUCTION

This Petition is Brown Bag's sixth effort to persuade a federal court that there is any merit to its claims in this lawsuit and its second effort to convince this Court that there was error of such gravity and significance that this Court should grant certiorari. Each previous effort failed. So must this one, for the Petition is utterly baseless and there is absolutely no reason to grant certiorari. The principal holding of the Ninth Circuit's unexceptional, unpublished ruling was that petitioner — after receiving due notice of a summary judgment motion — waived

its Lanham Act claim by failing to mention the Lanham Act claim in its opposition to summary judgment, by never once even referring to trade dress prior to the close of evidence in the district court proceedings, and by offering neither argument nor evidence in defense of the claim.

In light of Brown Bag's total indifference toward its Lanham Act claim in the district court, its insistence on pursuing the issue on appeal and in this Court is inexplicable except as an exercise in vexatious, spiteful litigation. There is no reason for this Court to devote its scarce resources to a review of such matters.

STATEMENT OF FACTS AND OF THE CASE

Notwithstanding certain inadequacies of petitioner's Statement of the Case, a few salient facts are sufficient for this Court to confirm that review by this Court would be inappropriate, indeed, pointless on the record herein.

A. Complaint and Discovery

On June 8, 1988, Brown Bag sued Symantec and Friend, alleging claims for copyright infringement, for violation of the Lanham Act, and for various state law wrongs. The Fourth Claim for Relief, titled "False Designation of Origin," is comprised in its entirety of a boilerplate paragraph incorporating the preceding allegations of the complaint (¶ 32), a paragraph alleging damages (¶ 35), and the following two paragraphs which contain all of Brown Bag's substantive allegations in support of its Lanham Act claim:

> "33. Defendants and their agents falsely promote [their computer software program] GrandView as being an upgrade, derivative or improvement upon [plaintiff Brown Bag's computer program] PC-OUTLINE in a manner to suggest a connection with Plaintiff. No such connection exists, and Plaintiff and Defendants are competitors. Such acts constitute a violation of Section 43(a) of the Trademark Laws of the United States.

> "34. The advertising, marketing and promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-OUTLINE. There is a likelihood of confusion, mistake or deception." (Complaint [District Court Docket No. 1], p. 9.)

The Complaint included no reference whatever to trade dress.

Although the Lanham Act claim was the subject of only limited discovery, defendant John Friend succeeded in identifying all of the facts that Brown Bag contended supported the claim. On October 11, 1988, Friend served contention interrogatories on Brown Bag. Under compulsion of one of the Magistrate's seven (7) discovery orders against Brown Bag and its principal Sanford Schupper (Docket No. 76), Brown Bag finally responded:

> "INTERROGATORY No. 31:
> "Do you contend that 'Defendants and their agents falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in a manner to suggest a connection with Plaintiff' as alleged in Paragraph 33 of your Complaint? If so, state each fact on which you base your contention.
> ...
>
> "RESPONSE TO INTERROGATORY NO. 31:
> "Symantec offers GrandView to PC-Outline owners at a drastically reduced price. GrandView can even accept PC-Outline files. John Friend even said on CompuServe [an electronic computer "bulletin board"], 'Once PC-Outline users use GrandView, they'll never look back.'"

(Plaintiff's Responses to First and Second Set of Interrogatories From Defendant John Friend (Warner Decl. in

Supp. S.Jmt., Exh. B [Docket No. 131]), pp. 42-43, hereafter "Br. Bag Interrog. Resp. [Docket No. 131]".)[4]

Brown Bag neither supplemented nor amended these discovery responses, which the defendants relied on in their summary judgment motions.

Symantec's and Friend's Motions for Summary Judgment

Following the close of discovery, defendant Symantec filed a Notice of Motion and Motion for Summary Judgment "on all of plaintiff's causes of action against defendant Symantec." The Notice of Motion specifically stated that there was an absence of evidence that Symantec falsely and misleadingly promoted GrandView as being an upgrade, derivative or improvement upon PC-Outline. (Docket No.120.) On the same day, John L. Friend moved for summary judgment "with respect to each of the claims of the Complaint." (Docket No. 129.) Each defendant also filed a supporting memorandum of law which specifically indicated that the false designation of origin claims were at issue. (Docket Nos. 127, 205.)

On April 19, 1989, Brown Bag filed "Plaintiff's Opposition to Both Defendants' Motions for Summary Judgment." (Docket No. 137.) Brown Bag's opposition brief offered no argument whatsoever in opposition to summary judgment on its Lanham Act claim, did not state that there was any evidence to support the Lanham Act claim, and did not mention or allude in any way to Brown Bag's Lanham Act cause of action.

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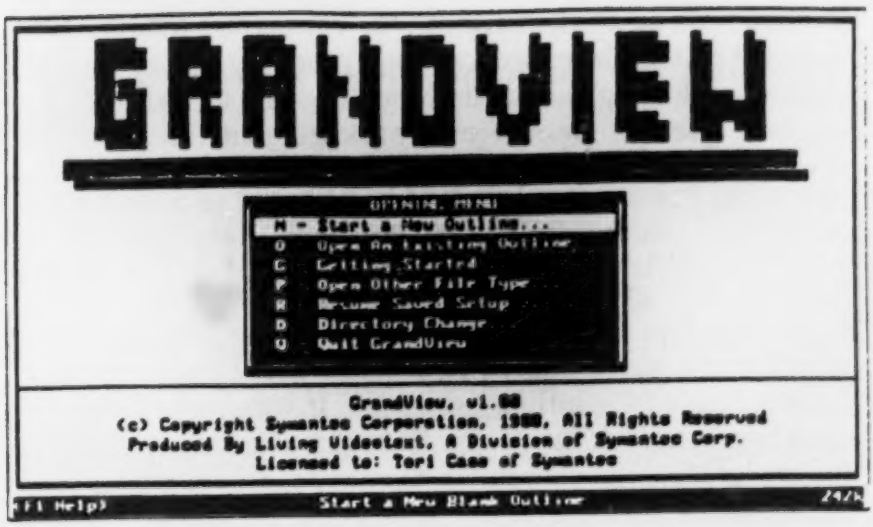
4 Friend's Interrogatory no. 32 similarly asked for every fact on which was based the contention of Paragraph 34 of the Complaint that "'the advertising, marketing and promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-Outline'"; Brown Bag's only response was to reference another interrogatory answer (No. 6), in which Brown Bag merely identified six reviews of the GrandView product.

Brown Bag did not state at any point in the summary judgment proceedings that the overall look and feel of its PC-Outline program constituted trade dress. Brown Bag did not state at any point in the summary judgment proceedings that GrandView's trade dress was confusingly similar to PC-Outline's. The evidence that was before the district court included neither the entire computer programs at issue nor any product packaging, and no declarant's testimony indicated that the total effect of GrandView's packaging and user interface could lead any consumer to believe that GrandView came from Brown Bag.

One of the screen displays submitted by Symantec did, however, bear on whether a user confronted with the computer screen displays of the two programs might be confused about whether she was using Symantec's GrandView program or Brown Bag's PC-Outline program. It was undisputed that each time a user of the programs began a session with one of the programs, the computer displayed a "opening menu" screen which identified the source of the programs. Below, we reproduce those initial "opening menu" screen displays for GrandView and PC-Outline. (Case Decl. in Supp. Mot.Strike, Exh. A [Docket No. 145].)


GRANDVIEW
OPENING MENU
N - Start a New Outline...
O Open An Existing Outline
G Getting Started
F Open Other File Type
R Resume Saved Setup
D Directory Change
Q Quit GrandView
GrandView, v1.00
(c) Copyright Symantec Corporation, 1988, All Rights Reserved
Produced By Living Videotext, A Division of Symantec Corp.
Licensed to: Tori Case of Symantec
Start a New Blank Outline

WELCOME TO PC-OUTLINE - HAVE FUN!
OPENING MENU
Open a new outline
Load an Existing Outline
Drive/Dir
Quit
(c) Copyright 1986,87 Brown Bag Software, All Rights Reserved
Directory C:\PCO

The overall appearance of these opening screens is manifestly different. It is impossible to imagine anyone confusing the two. PC-Outline's opening screen display says "WELCOME TO PC-OUTLINE," and identifies "Brown Bag Software" as the copyright holder. GrandView, on the other hand, is identified in distinctive letters more than one inch tall, and the screen display clearly states: "Produced by Living Videotext, A Division of Symantec Corporation." No wonder Brown Bag decided not to introduce such evidence relating to its claim! Given these screen displays, any claim that a user might confuse the two programs or believe that GrandView comes from Brown Bag is ludicrous.

On September 7, 1989, following the reply briefs, an in-court demonstration of the two programs and supplemental letter briefing, the district court ruled on the summary judgment motions. *Telemarketing Resources v. Symantec Corp.*, 12 U.S.P.Q.2d (BNA) 1991 (N.D. Cal. 1989). The court granted summary judgment against Brown Bag's copyright claims, dismissed without prejudice the pendant state claims, and omitted to rule expressly on the Lanham Act claims. *Id.* at 1996.

Subsequent Proceedings

Brown Bag's first appeal followed. The Ninth Circuit (i) affirmed the grant of summary judgment against Brown Bag's copyright claims, (ii) upheld the Magistrate's exercise of discretion providing Brown Bag with only limited, conditional access to confidential documents belonging to its competitor Symantec, and (iii) remanded Brown Bag's Lanham Act claim for clarification as to whether or not the district court had intended to grant summary judgment.[5] *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465 (9th Cir. 1992).

Although the Ninth Circuit held that "Brown Bag [had] failed to offer any evidence pertaining to the Lanham Act

---

5 The first two issues were the subject of Brown Bag's previous certiorari petition (No. 92-178).

claim, and therefore failed to carry its evidentiary burden in opposing summary judgment," the court declined "to infer a district court's decision on an entire claim." *Brown Bag*, 960 F.2d at 1477, 1478. "We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion." *Id.* at 1478.

On or about June 25, 1992, Brown Bag filed its first petition for certiorari, which was denied on October 5, 1992 (113 S.Ct. 198). The case was thereupon returned to the district court for clarification as the Ninth Circuit had ordered.

Following a status conference at which the parties were heard, but no new evidence offered or received, on November 12, 1992 the district court entered its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim:

> "Although not stated expressly in its previous order granting summary judgment, the court had intended to grant summary judgment on all federal claims, i.e. the trademark claim as well as the copyright infringement claim. This order amends and clarifies the previous summary judgment and GRANTS Defendants' motion for summary judgment on the trademark claim under the Lanham Act for false designation of origin.'
>
> ". . . [I]n its opposition , *Plaintiff presented no evidence* in support of its claim for false designation of origin. In fact *Plaintiff did not even mention the Lanham Act in its opposition brief.*" (Pet. App. p. b3, emphasis added.)

On November 25, 1992 the district court entered Judgment Nunc Pro Tunc, granting judgment on the Lanham Act claim nunc pro tunc to September 7, 1989. Brown Bag thereafter took its second appeal. The Ninth Circuit affirmed in an unpublished memorandum decision filed June 28, 1994.

REASONS FOR DENYING THE WRIT

I.

THE SUFFICIENCY OF THE NOTICES OF MOTION TO ADVISE BROWN BAG THAT SUMMARY JUDGMENT WAS SOUGHT IS NOT AN ISSUE WHICH REQUIRES THIS COURT'S ATTENTION

Petitioner slyly seeks to substitute a new claim for the one that was presented to and decided by the Ninth Circuit. This is understandable because the claim asserted in the appeal — that "the moving parties [failed to] provide adequate notice that they were moving for summary judgment on Brown Bag's Lanham Act" claim (Open.Br. p.2) — is patently indefensible. Instead, Brown Bag asks this Court to grant certiorari so that it can address a different issue from the one Brown Bag put before the Ninth Circuit, namely, whether the statement of the "grounds" for the summary judgment motion was sufficiently detailed.

Neither issue, however, is meritorious and neither issue warrants this Court's attention, particularly since the Ninth Circuit's unpublished ruling is of no significance to anyone other than the immediate parties to this dispute.

A. Brown Bag Was Plainly On Notice That Summary Judgment Was Sought Against Its Lanham Act Claim.

Under *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), when a party "point[s] out to the district court . . . that there is an absence of evidence to support the nonmoving party's case," the nonmoving party is obliged to "come forward with all of [its] evidence." 477 U.S. at 325, 326. The district court in this case granted summary judgment against Brown Bag's Fourth Claim for Relief, observing that Brown Bag failed,

after notice, to present evidence in support of its false designation of origin claim. (Pet. App. pp. b2-4.)

On appeal, Brown Bag made the extraordinary claim that there was an issue as to whether Brown Bag knew the defendants were moving for summary judgment on the claim: "Did the moving parties provide adequate notice that they were moving for summary judgment on Brown Bag's Lanham Act trade dress claim for false designation of origin?" Opening Brief p. 2. The Ninth Circuit correctly rejected the claim:

> "Even though Brown Bag argues that it didn't realize summary judgment was being sought on its Lanham Act claim, Symantec's notice of motion indicates that it sought judgment on all claims; moreover, the grounds offered in support include the absence of evidence that Symantec falsely promoted GrandView as being an upgrade, derivative, or improvement upon PC-Outline, tracking exactly Brown Bag's fourth claim for relief." (Pet. p. d3.)

Brown Bag's claim of surprise is completely disingenuous, and the issue is wholly frivolous. The record belies any claim there was insufficient notice. Indeed, four separate pleadings put Brown Bag on notice that the Lanham Act claim, among others, was the subject of the summary judgment motion.

First, Symantec's March 31, 1989 Notice of Motion and Motion for Summary Judgment stated in relevant part:

> "[D]efendant Symantec Corporation ('Symantec') will move this Court for an Order Granting Summary Judgment in favor of Symantec pursuant to Federal Rules of Civil Procedure, Rule 56, ***on all of plaintiff's causes of action*** against defendant Symantec." (Docket No. 120, emphasis added)

Symantec's Notice of Motion further stated:

> "This motion for summary judgment is based on the grounds that ... (4) ***there is no evidence that***

> *Symantec or its agents falsely promoted GrandView as being an upgrade, derivative or improvement upon PC-Outline* in [a] manner as to suggest a connection with plaintiff or to mislead consumers as to the source of GrandView." (Docket No. 120, emphasis added)

Second, defendant Friend's Notice of Motion and Motion for Summary Judgment also informed Brown Bag:

> "[D]efendant John L. Friend will move the Court for an Order Granting Summary Judgment in his favor and against [Brown Bag] *with respect to* ***each of the claims*** *of the Complaint*." (Docket No. 129, emphasis added)

Finally, both of the defendants' legal memoranda clearly identified the issue, referenced the relevant allegations of plaintiff's Fourth Claim for Relief, the Lanham Act claim, and specifically stated that there was no evidence to support the allegations.[6]

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[6] Friend's Memorandum of Points and Authorities in Support of Motion for Summary Judgment (Docket No. 205) includes a section titled "False Designation of Origin (Fourth Claim)." The section stated: "In this claim, plaintiff contends that defendants falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in violation of Section 43(a) of the Lanham Act. Complaint, ¶33. ... [P]laintiff is unable [to] show that defendants are promoting GrandView as being connected with or a derivative of PC-Outline." (Docket No. 205, pp. 23-24, original emphasis.)

Symantec's memorandum in support of summary judgment did not mention the words "Fourth Claim for Relief," but it recited every substantive allegation of ¶¶ 33 and 34 of the Complaint and stated "that there is no evidence to sustain [those] allegations." (Docket No. 127, p. 38, fn.24.) "Symantec further contends that there is no evidence to sustain the allegations that Symantec or its agents falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in a manner as to suggest a connection with plaintiff, nor is there any evidence that the

Brown Bag complains about the fact that one of the references to its Lanham Act claim was a footnote to a section of Symantec's memorandum which addressed state law claims and Brown Bag also disputes the relevance of part of Friend's legal analysis. (Pet. pp. 17-18.) But its counsel (the same here as in the district court) does not state that he never read the footnotes nor that he did not read the two Notices of Motion nor the section in defendant Friend's brief headed, "False Designation of Origin (Fourth Claim)." Possibly, the Federal Rules may be amended one day to require multimedia notices, sound bites or scratch-and-sniff stickers to attract the attention of counsel. For now, however, we understand the Rules as embodying a conclusive presumption of literacy on the part of counsel for a party. A Notice of Motion which explicitly states that all claims are being attacked on summary judgment puts the party on notice of what it says.

B. Brown Bag 's Contention That the Grounds For the Motion Were Insufficiently Stated Is Equally Meritless.

It is not entirely clear why petitioner contends that the grounds for the summary judgment were stated with insufficient particularity or what the contentions means. But this Court need not detain itself over this variant of the issue presented to the Ninth Circuit for three reasons.

First, if Brown Bag is saying anything different from the above argument that it did not realize defendants were moving for summary judgment, it has no right to ask this Court to consider it for the first time. This Court cannot review issues never presented to the Courts of Appeal.

Second, it is unnecessary and impossible to state the grounds for the motion with any more particularity than the defendants did. Brown Bag's Lanham Act claim alleged

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advertising, marketing or promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-Outline ....." (*Id.*) *Compare* with substantive allegations of Complaint, Fourth Claim for Relief (Docket No. 1, p. 9:12-20).

certain facts. Defendants knew that the factual allegations were a sham and lacked any basis whatever. As expressly authorized by this Court's decision in *Celotex Corp.v.Catrett*, 477 U.S. 317 (1986), they clearly so stated, identifying the specific factual allegations and elements of the claim which defendants contended were baseless. That was sufficient under Rule 56 and under established law.

Third, "the parameters of FRCP 7's requirement that the grounds of motions be stated with particularity" (Pet. p. i) cannot be defined in the abstract, but is a matter to be raised in district court if a party truly cannot comprehend the basis of a motion. Defendants' motions made it quite clear that they sought summary judgment on the Lanham Act claim. If Brown Bag actually did not understand the basis of the motions, Brown Bag should have objected there and then — not for the first time years later on appeal or in a petition for certiorari. Still less is it imaginable that this Court should engage in the business of parsing motions to see whether they should be more specific, after a district court and a court of appeals has considered the sufficiency of the notice.

In the face of the record, Brown Bag's contention that there is an issue about whether defendants "provide[d] adequate notice that they were moving for summary judgment" on the false designation of origin cause of action is not merely frivolous, it is deceitful.

II.

BROWN BAG WAIVED ANY TRADE DRESS CLAIM BY FAILING TO ASSERT IT IN TIMELY FASHION

Petitioner asks this Court to take up certain supposedly novel issues concerning its contrived trade dress claim, but petitioner entirely ignores the basis of the Ninth Circuit's actual ruling, a ruling which would render moot any decision this Court could render on the submitted issues. Although the Ninth Circuit commented, in the alternative, on the inadequacy of Brown Bag's factual showing as to the "distinctiveness" of

Brown Bag's alleged trade dress, that court's principal holding — which Brown Bag does not allude to and does not ask this Court to review — was that Brown Bag simply waived the issue:

> "[Brown Bag's] argument fails because the [trade dress] issue was raised after the record on summary judgment was closed, [and] Brown Bag's opposition contains neither argument nor evidence pertaining to its claim for false designation of origin . . . ." (Pet. p. d3.)

The Ninth Circuit's holding was inescapable, for it is established beyond peradventure that an issue not argued to the district court is waived on appeal.[7] In this case, not only did Brown Bag fail to raise its trade dress theory of false designation of origin during the course of the summary judgment proceedings, Brown Bag failed to raise *any* argument or theory in defense of its Lanham Act claim. Brown Bag did not even let the trial judge know that Brown Bag opposed summary judgment on the Lanham Act claim. As the district court noted in its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim, "Plaintiff did not even *mention* the Lanham Act in its opposition brief." (Pet. App. p. b3.) Even though Brown Bag was put on notice that the Fourth Claim for Relief (among others) was at issue, Plaintiff's Opposition to Both Defendants' Motions for

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7 *Dumas v. Gommerman*, 865 F.2d 1093, 1095 fn. 3 (9th Cir. 1989) ("Since this argument was not presented at the district court level, it cannot be raised for the first time on appeal"); *Pye v. Mitchell*, 574 F.2d 476, 480 (9th Cir. 1978) ("[Appellants] tender this argument for the first time on appeal. That is too late.... Where an issue is conceded below, it cannot be raised for the first time on appeal."); *Liberles v. County of Cook*, 709 F.2d 1122, 1126 (7th Cir. 1982) ("It is a well-settled rule that a party opposing a summary judgment motion must inform the trial judge of the reasons, legal or factual, why summary judgment should not be entered. If it does not do so, and loses the motion, it cannot raise such reasons on appeal.").

Summary Judgment chose to remain totally silent about the Lanham Act claim.

Having failed to tell the district court there was any reason not to grant summary judgment on the Lanham Act claim — having abandoned the issue by failing to tell to the district court that Brown Bag desired to defend the claim at all — Brown Bag was barred from raising the claim on appeal.[8]

There is no basis for overturning the finding of waiver, and — of critical importance to this Court's jurisdiction — Brown Bag has not requested this Court to do so. In asking this Court to consider other, substantive issues without asking the Court to review the Ninth Circuit's finding of waiver, petitioner asks this Court to render advisory opinions concerning the other issues.

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8 Brown Bag did present argument on its trade dress theory at the district court's November 26, 1992 status conference, following the Ninth Circuit's remand to clarify the earlier ruling, but it was three years too late for Brown Bag to argue in defense of its Lanham Act claim. The Ninth Circuit neither *reversed* the district court's earlier judgment nor ordered the district court to *reopen* the summary judgment proceedings. Rather, the court of appeals only directed the district court, on remand, to *clarify its earlier ruling*. As indicated by the entry of judgment "nunc pro tunc" and by the district court's explanation of its order granting summary judgment, the district court did precisely that. The clarification was that the district court had intended to grant summary judgment on the Lanham Act claim as part of its September 7, 1989 judgment. (Pet. App. pp. b3, c2.) Having failed to argue in favor of its Lanham Act at any time prior to the submission of the summary judgment issues for decision in May 1989, Brown Bag has waived its Lanham Act Claim for Relief.

III.

THE NINTH CIRCUIT CORRECTLY APPLIED THE LAW ON "DISTINCTIVENESS" OF TRADE DRESS

Brown Bag asks the Court to review the issue: "Are distinctiveness and secondary meaning both indispensable elements of a trade dress cause of action?" (Pet. p. i [Question Presented II]). There is no reason to grant certiorari to consider that issue because this Court recently resolved the question in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. __, 120 L.Ed.2d 615, 112 S. Ct. 2753 (1992), unambiguously holding that a trade dress claimant need not show secondary meaning if the trade dress was proven inherently distinctive.

Brown Bag contends that the Court of Appeals erroneously believed that *both* distinctiveness and secondary meaning must be shown, pointing to the language from the Ninth Circuit's memorandum decision which states that "there is no evidence raising a triable issue of fact on distinctiveness and secondary meaning -- which are indispensable elements." Although the formulation is arguably ambiguous, there is no reason to believe that the Ninth Circuit did not understand the correct standard, no reason to believe that it misapplied that standard, and no reason for this Court to parse the factual record of this case in order to supervise the court of appeal's supervision of the application of summary judgment standards to the routine facts of this case.

First, the Ninth Circuit did not apply the wrong legal standard. Both parties' appeal briefs cited *Two Pesos* and both parties clearly advised the court of appeals that "inherent distinctiveness" and acquired "secondary meaning" are *alternative* means of demonstrating the distinctiveness

necessary for a trade dress claim.[9] It is therefore unimaginable that the Ninth Circuit misapprehended the law. What the Ninth Circuit obviously intended to express were its conclusions — again not subject to serious dispute — that there was no evidence of inherent distinctiveness *and* no evidence of secondary meaning, and that it is indispensable that a plaintiff present evidence of one of the two elements.

Second, the conclusion that there was no evidence of either inherent distinctiveness or secondary meaning is unimpeachable. Although Brown Bag now asserts that evidence of "copying" is sufficient to raise a triable issue concerning secondary meaning, in reality there was no evidence of copying either![10]

Third, even if Brown Bag had presented to this Court a marginally credible claim that the district court and the Ninth Circuit both erred in their application of summary judgment standards to the meager "evidence" submitted by Brown Bag, Brown Bag states no reason why the Supreme Court should grant review. Petitioner does not appear to understand that this Court's role is not to look over the shoulder of every court of appeals to make sure it does its job. The Ninth Circuit, it is undisputed, applied the established legal standards in

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9 Brief of Defendant-Appellee Symantec Corporation, p. 23; Opening Brief for Plaintiff-Appellant Brown Bag Software, p.22.

10 Respondent Symantec pointed out to the district court and to the Ninth Circuit that Brown Bag was bound by its interrogatory responses. One of those interrogatory responses specifically asked Brown Bag whether it contended that "Friend [had] knowingly and willfully copied ... PC-Outline," and if so, to state all facts on which Brown Bag based its contention of copying. Brown Bag's entire answer was: "Obviously due to the fact that Friend admittedly wrote both PC-Outline and GrandView solely on his own." Br. Bag Interrog. Resp. [Docket No. 131], pp. 11-12. The "facts" identified in Brown Bag's answer were insufficient to create a triable issue on whether PC-Outline's trade dress had secondary meaning.

reviewing *de novo* the district court's grant of summary judgment. Petitioner fails to explain what was so unusual in the Ninth Circuit's unpublished decision as to warrant this Court's attention.

IV.

THIS CASE IS NOT A SUITABLE VEHICLE FOR CONSIDERING THE CIRCUMSTANCES IN WHICH THE "LOOK AND FEEL" OF A COMPUTER PROGRAM MIGHT CONSTITUTE TRADE DRESS.

Brown Bag asks the Court to consider the supposedly novel question of whether the (undefined) "look and feel" of a computer software program can constitute a form of trade dress protectable under the Lanham Act. The case is not suited for and in fact defies such review for two related reasons.

A. The Record Is Completely Undeveloped On The Trade Dress Issue.

Since the trade dress issue was never raised until after the close of discovery and after the record was closed on summary judgment, both the facts and the legal considerations pertaining to this difficult and disturbing issue were completely undeveloped in the district court. It would be imprudent for this Court to attempt to assess the implications of such an expansion of the "trade dress" doctrine in a case in which the issues have neither been fully developed in discovery nor fully analyzed in the proceedings leading to judgment. No discovery in this case could focus on trade dress since the petitioner did not even hint at any such theory until the case was on appeal. Even the scope of the claim is undefined, since the term "look and feel" has no well-settled or precisely-defined meaning either in the computer software industry or in legal parlance. The scope, consequently, of Brown Bag's trade dress claim is therefore unknown and unknowable.

Among the issues to be carefully assessed, if this Court were some day to consider the application of the trade dress doctrine to the "total image" of computer software programs, are the following: Just what is the "look and feel" of a program, and does that formulation refer to something different from the more common term, "user interface"? Does it matter if the computer program at issue is a video game, a stand-alone business application or something else? Is the user interface at issue primarily textual or graphic? To what extent, if any, is the user interface known to consumers when they make their purchase decision? If computer software is prominently labeled as to source at the point of sale, can alleged similarities of user interfaces nonetheless generate consumer confusion? Are user interfaces entirely functional in character? What evidence is there that consumers actually consider any unusual aspects of a user interface to be "distinctive" in the trademark sense — meaning indicative of source? If the entirety of a product, as it is perceived by consumers, is asserted to constitute its "trade dress," what implications does this have for the presumptions often applied to trademark analysis under the Lanham Act? And, perhaps most important, if the user interface of a program is not protectable under copyright or patent law, can the very same elements be effectively withdrawn from the public domain merely by being dubbed "trade dress"?

Few, if any, of these important questions can be meaningfully explored in this case because of the paucity of the record; and if this Court granted certiorari in order to address such issues, the Court would not have the benefit of the thinking of the district court or of the courts of appeal, since the petitioner raised its trade dress theory too late for these difficult legal issues to have been considered below. Certiorari is inappropriate in such circumstances.

B. Plaintiff Presented Insufficient Evidence To Withstand Summary Judgment

It would be pointless for this Court to render an opinion on whether a computer program's "look and feel" is protectable as trade dress, in the abstract, when in the case at hand the

plaintiff clearly failed to make a sufficient showing to withstand summary judgment even if "look and feel" can be trade dress. Three points ineluctably compel this conclusion.

1. The Only Facts Stated In Brown Bag's Discovery Responses Were Insufficient To Establish Any Of The Necessary Elements Of A Trade Dress Claim.

To prevail on a trade dress claim, a plaintiff must show that its trade dress is inherently distinctive or has acquired secondary meaning, that it is nonfunctional, and that there is a likelihood defendant's trade dress will be confused with plaintiff's. *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 841 (9th Cir. 1987). None of the purported facts stated in support of the Lanham Act claim in the interrogatory response quoted above (Docket No. 131) is sufficient to create an issue of material fact on any of these issues:

- "*Symantec offers GrandView to PC-Outline owners at a drastically reduced price.*" Vigorous price competition is neither an infringement of trade dress nor probative of any fact relevant to trade dress.
- "*GrandView can even accept PC-Outline files.*" This feature — which refers to file compatibility — actually tends to refute any Brown Bag claim of nonfunctionality, but is probative of no other trade dress issue.
- "*John Friend even said on CompuServe, 'Once PC-Outline users use GrandView, they'll never look back.'*" This statement of GrandView's superiority has nothing to do with trade dress and certainly does not establish likelihood of confusion or any other Lanham Act element.

The listed "facts" do not remotely suggest that PC-Outline has inherently distinctive trade dress or secondary meaning nor that its look and feel is nonfunctional nor that consumers are likely to be confused by GrandView's user interface. Summary judgment was, consequently, compelled.

2. Brown Bag Never Submitted The Essential Evidence For A Trade Dress Claim, The Entire Programs And Their Packaging.

Brown Bag's Lanham Act claim represents an effort to exhume its defunct "total look and feel" copyright claim by affixing to the same claim the label "trade dress." However, Brown Bag closes its eyes to an insuperable obstacle to its claim, namely, that Brown Bag never submitted, in its opposition to summary judgment, the only direct evidence of the programs' "overall look and feel" — the complete programs themselves, including their packaging. One of the critical issues in a trade dress case is "whether there is a likelihood of confusion resulting from *the total effect of the defendant's product and package* on the eye and mind of the ordinary purchaser." *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383-84 (9th Cir. 1987), emphasis added. Accord, *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989), cert. denied, 493 U.S. 1075 (1990) (trade dress encompasses "overall appearance of a product" including packaging). Yet Brown Bag introduced neither any product packaging nor the "total" products GrandView and PC-Outline in opposing summary judgment. Since the presentation of the entire programs, with their packaging, is clearly an essential predicate to any conclusion that consumers could be confused by the "total effect of the defendant's product and package on the eye and mind of the ordinary purchaser," *First Brands*, Brown Bag's omission was fatal to its Lanham Act trade dress claim.

3. The Fragmentary Evidence Proffered By Brown Bag Did Not Create A Genuine Issue Of Material Fact On Any Of The Necessary Elements Of A Trade Dress Claim.

Even if, in opposing to summary judgment, Brown Bag were permitted to adduce facts beyond its discovery responses, none of the evidence Brown Bag submitted in support of its copyright claim would be sufficient to sustain

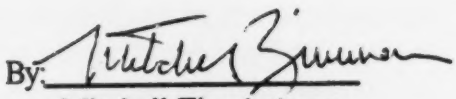
the trade dress claim. Brown Bag had not devised its trade dress theory at the time it filed its opposition to summary judgment on its copyright claim, hence Brown Bag never explained how the evidence submitted at that time related to the essential elements of a trade dress claim — nonfunctionality, distinctiveness, or likelihood of confusion. The evidence in fact supports none of those elements. Brown Bag's petition does not even attempt to explain how, from that evidence, an inference could be drawn that there is a triable issue as to each of the required elements. Since there is not, even if all other obstacles could be overcome, affirmance of the district court judgment would still be required.

CONCLUSION

Petitioner Brown Bag's six-year vendetta against the defendants brings it to this Court a second time, on claims even more clearly devoid of merit than those previously asserted. The Petition raises no issues worthy of this Court's attention. Respondent Symantec respectfully prays that the Court deny the petition.

DATED: November 9, 1994

FENWICK & WEST

By: 

Mitchell Zimmerman

Attorneys for Respondent
Symantec Corporation